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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/519,389

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EXAMINER

WOOD, KIMBERLY T

ART UNIT

PAPER NUMBER

3632

MAIL DATE

DELIVERY MODE

02/26/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/519,389	Applicant(s) PARK, SEUNG BAE	
	Examiner Kimberly T. Wood	Art Unit 3632	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 4-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 4-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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This is an office action for serial number 10/519,389.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 7 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the sidewalls having a toothed wheel or the inner annular surface having a female thread and the hinge pin having male threads corresponding to the female threads, respectively, does not reasonably provide enablement for the sidewall having a toothed wheel and the inner annular surface having a female thread and the hinge pin having male threads corresponding to the female threads within the same hinge. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make the invention commensurate in scope with these claims.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4, 5, 8, 9, 10, 13-15 are rejected, as best understood, under 35 U.S.C. 103(a) as being unpatentable over Ko 1020020066148A in view of Okeke et al. (Okeke) 2001/0023518. Ko discloses a fixing member (4); a connection member (upper part of 19 opposite the hinge area) being a body having an opening (near 15), holes (near 16), a resilient piece having a button (18); hinges (19 and 17); the detachably-attaching member (6) having a resilient hook (11); sunglasses (3); and a cap visor (1). Ko discloses all of the limitation of the claimed invention for the fixing member being a body having an opening and a fixing means for fixing the body to the cap and the detachable attaching member being coupled to and the connection member being coupled to the sunglasses. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have the fixing member being the body having the

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opening, a resilient piece having a button projected through the hole with a fixing means being fixable to the cap and the connection member and detachably-attaching member being coupled to the sunglasses, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167. Ko discloses all of the limitations of the claimed invention except for the hinges having a toothed wheel and hinge pin. Okeke discloses it is known to have a hinge having a toothed wheel and a hinge pin (Figure 7). It would have been obvious to one having ordinary skill in the art to have modified Ko to have included the toothed wheel and pin as taught by Okeke for the purpose of providing somewhat fixed positioning when adjusting the sunglasses relative to the cap therefore preventing accidental repositioning. It would have been obvious to one having ordinary skill in the art at the time the invention was made to the molded or inseparable assembly into a separable or detachable hinge member as is commonly known in the art (see Kiefer 5,361,455 as conventional separable hinge member which teaches it is known to have a pin (98) insertable through hinges (120, 90) or see Ryder 5,987,640 (near element 54) or Simone 5,720,040 (near element 37 see figures 7-9 which show conventional separable hinge assemblies) since it has been held that

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constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

Claim 6 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ko, in view of Okeke et al. (Okeke) 2001/0023518, as discussed above, in view of Kiefer 5,361,455. Ko discloses all of the limitations of the claimed invention except for the fixing member including a bolt, a support plate integrally formed at both sides of the body and having a hole. Kiefer teaches that it is known to have a fixing member including a bolt (88), a support plate (38) integrally formed at both sides of the body (36) and having a hole (66). It would have been obvious to one having ordinary skill in the art to have modified Ko to have included the including a bolt, a support plate integrally formed at both sides of the body and having a hole as taught by Kiefer for the purpose of providing a better means of attaching the fixing member which allows detachment.

Claims 7 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ko, in view of Okeke et al. (Okeke) 2001/0023518, as discussed above, in furtherer view of Miller et al. (Miller) 5,933,919, as best understood. Miller discloses all of the limitations of the claimed invention except for the

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female thread at the inner circumference and the pin having a male thread from on the outer circumference. Miller teaches that it is known to have a the female thread at the inner circumference (5-9) and the pin having a male thread from on the outer circumference (10). It would have been obvious to one having ordinary skill in the art to have modified Ko in view of Okeke to have included the toothed wheel and pin as taught by Miller for the purpose of providing somewhat fixed positioning when adjusting the sunglasses relative to the cap therefore preventing accidental repositioning or accidental removal.

Claims 7 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ko, in view of, as discussed above, in furtherer view of Miller et al. (Miller) 5,933,919, as best understood. Miller discloses all of the limitations of the claimed invention except for the female thread at the inner circumference and the pin having a male thread from on the outer circumference. Miller teaches that it is known to have a the female thread at the inner circumference (5-9) and the pin having a male thread from on the outer circumference (10). It would have been obvious to one having ordinary skill in the art to have modified Ko to have included the toothed wheel and pin as taught by Miller for the purpose of providing somewhat fixed positioning when adjusting the sunglasses relative to the cap

therefore preventing accidental repositioning or accidental removal.

Response to Arguments

Applicant's arguments filed November 28, 2007 have been fully considered but they are not persuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). The applicant's arguments are directed to Okeke teaching a molded inseparable assembly however the examiner is only using Okeke to teach that it is obvious to modified a separable hinge members (17 and 7) of KO to be modified to include a still separable hinge member of the original description of KO to become a hinge member which is still separable but now including the teaching of a hinge member that has a toothed wheel formed on the sidewalls as taught by Okeke. The modification does not make the separable hinge of Okeke inseparable it only improves the hinge by providing somewhat fixed positioning when adjusting the sunglasses

relative to the cap therefore preventing accidental repositioning.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the knowledge generally available to one having ordinary skill in the art leads the examiner to the motivation and/or suggestion to combine the references since hinges are old and conventional in the art and various types of separable hinges are mechanical equivalents therefore being obviously interchangeable and it would be common sense to modify or substitute conventional separable hinges depending on the desire of the user due to cost effectiveness or to facilitate positioning.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kimberly T. Wood whose telephone number is 571-272-6826. The examiner can normally be reached on Monday-Thursday 7:30am to 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Glessner can be

reached on 571-272-6843. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kimberly T. Wood/
Kimberly T. Wood
Primary Examiner
Art Unit 3632

February 18, 2008